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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/370,619	08/07/1999	MICHAEL DAVID ERLANGER	114459-05	8285

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EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3624

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/370,619	Applicant(s) ERLANGER, MICHAEL DAVID	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 186-303 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 186-303 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 186-303 are pending in this communication filed 08/15/05 entered as Response to Election/Restriction.
2. The Previous Election/Restrictions of 07/14/04, 11/15/04, and 4/21/05 are withdrawn in view of the present Election/Restriction Requirement as set forth here below.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 186, drawn to matching loan applicants to lenders and collecting data during loan origination and making it available in the secondary market classified in class 705, subclass 38.
 - II. Claims 187-212 and 213-224, drawn to a market for a class of financial products and a predetermined pricing schedule for intermediation services providing credit for transaction fees, classified in class 705, subclass 39.
 - III. Claims 225-263, 299, and 300-302, drawn to a method on a secondary market for buying and selling loans to consumers and/or lines of credit to customers, classified in class 705, subclass 37.
 - IV. Claims 264-286 and 303, drawn to a method for an application process for financial products offered by offerors, classified in class 705, subclass 30.
 - V. Claims 287-298, drawn to a method and computer for obtaining information from an applicant for a financial product with information

relating to the qualifications of the applicant, classified in class 705, subclass 1.

Inventions Group II and Group V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group II has separate utility such as the trading of products. This Group II can be used in another environment such as over the Internet trading services or products. Group V has separate utility such as obtaining information from an applicant and matching the information against underwriting standards of a offerors and identifying to the applicant the offerors that have underwriting standards that the applicant meets, This Group V can be used in another environment such as making a purchase for an automobile where an application is taken prior to making the purchase. See MPEP § 806.05(d) Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable are usually distinct from each other.

Group IV and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group IV has a database for

Art Unit: 3624

storing the solicitation of information and updating the database with information describing the closed financial products. The subcombination has separate utility such as obtaining the information from the applicant and receiving and storing the underwriting standards of the offerors of the financial product. Group IV can be used in any environment where a database is needed to store a collection of data on a computer storage medium such as a disk. Group V can be used in another environment such as making a purchase for an automobile where an application is taken prior to making the purchase. MPEP 806.05 (c) To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP 808.02. In this instance Group IV and Group V are in a separate field of search and classification.

Group I, claim 186 links inventions Group III, claims 225-263, 299 and 300-302. The restriction requirement claims 225-263, 299 and 300-302 the linked inventions is **subject** to the nonallowance of the linking claim(s), claim 186. **Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application.** Applicant is advised that if any such claim(s) depending from or including all of the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is

Art Unit: 3624

withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-31 (CCPA 1971). See also MPEP 804.01.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, Group III, Group IV, and Group V, the search for Group II is not required for Group I, Group III, Group IV, and Group V, the search for Group III is not required for Group I, Group II, Group IV, and Group V, the search for Group I, Group II, and Group III, Group V is not required for Group IV, and the search for Group I, Group II, Group III, and Group IV is not required for Group V restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. **Applicant is advised that the reply to this requirement to be completed must include an election to only one Group of the invention to be examined even**

though the requirement be traversed (37 CFR 1.143). For example, Applicants' elect group II without traverse or Applicants' elect Group II with traverse and the claims to the remaining inventions are withdrawn.

Response To Arguments

9. The response to Applicants' arguments have been addressed at least twice and there is no further need to readdress the same arguments again.


Applicants' are advise to make an election to one invention (one Group of claims) and only one group of claims to be examined. Applicant electing a first alternative election, a second alternative election, a third alternative election, etc. is considered to be nonresponsive to the election/restriction requirement. The MPEP818.03 (b) "a provisional election must be made even though the requirement is traversed 37 CFR 1.143. MPEP 818.03 (e) Applicant must make his or her own election. The Examiner will not make the election for the applicant. 37 CFR 1.142, 37 CFR 1.143, second sentence. MPEP 819 The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter.

Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


E. Colbert
Primary Examiner
October 31, 2005